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Polster, Lieder, Woodruff & Lucchesi, L.C. 12412 Powerscourt Dr. Suite 200 St. Louis, MO 63131-3615			NELSON, FREDA ANN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,416	Applicant(s) YATES, JAMES M.	
	Examiner FREDA A. NELSON	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment received on 07 January 2011 is acknowledged and entered. Claims 1-20 have been canceled. Claims 21-37 have been added. Claims 21-37 are currently pending.

Response to Arguments

1. Applicant's arguments with respect to claims 21-37 have been considered but are moot in view of the new ground(s) of rejection.

Specification

2. The disclosure is objected to because of the following informalities:
3. On page 15, line 26, "I" should be "is".
Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 22, 24-27, 29-30, 33-35, and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. As per claims 22 and 26, although on page 17, lines 10-12, the specification recites “The DCE 100 does not reproduce the file for items in the locker, but maintains a database record of the items contained in each locker 122”, the Examiner is unable to locate in the instant application, “the step of receiving, from an owner of the item, a physical copy of the item prior to determining whether the digital master of the item exists in the central media database, *wherein the commercial exchange immobilizes the physical copy of the item*”.

7. As per claims 24, 30, 33, and 37, the Examiner is unable to locate in the disclosure of the instant application “receiving, from the verified legal owner of the item, permission to permanently transfer ownership rights in the item to another; and receiving, from the acquirer, *a request to permanently transfer ownership rights* in the item to the acquirer.

8. As per claim 29, the Examiner is unable to locate in the disclosure of the instant application “receiving, from the verified legal owner of the item, permission to transfer ownership rights in the item to *another for a predetermined period of time*; and

wherein the owner is denied access to the item *prior to the expiration of the predetermined period of time*; and

updating the list of unique owner identifiers and the associated unique digital master identifiers to reflect that the owner, rather than the acquirer, *is the verified legal*

owner of the item after the expiration of the predetermined period of time.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claims 21, 23, 32, and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Durand et al.* (WO 02/054196 A2), in view of *Adelsbach et al.* (US Patent No. 6,856,977).

12. **As per claim 21**, *Durand et al.* discloses a method for operating a commercial exchange of an item, said method comprising the steps of:

receiving, from an owner of the item, a request to list the item on the commercial exchange (page 1, lines 33-37; page 3, line 33- page 4, line 4);

determining whether a digital master of the item exists in a central media database, storing the digital master in the central media database and assigning a unique identifier associated with the digital master when the digital master of the item does not exist in the database and selecting the unique identifier associated with the digital master when the digital master of the item does exist in the database (page 5, lines 3-8, page 8, lines 13-19; page 6, lines 13-19; page 16, lines 7-11);

assigning a unique owner identifier to the digital master of the item stored in the central media database, the unique owner identifier associating the verified legal owner of the item with the digital master (page 2, lines 8-11, page 16, lines 13-19, page 25, line 23- page 26, line 3);

maintaining a list of the unique owner identifiers and the associated unique digital master identifiers in the central media database (page 16, lines 7-11); and

Durand et al. does not explicitly disclose verifying that the owner legally possesses the item; and operatively associating the central media database with an exchange interface structured and operable to execute a transaction between at least one of the verified legal owner and an acquirer.

Adelsbach et al. discloses an ownership certificate for proof of rightful copyright owner of a work is provided by a protocol for registering the work. Two protocols are provided to prove to a buyer that an ownership claim is valid by providing the certificate as required, and to show another buyer that work is obtained from rightful owner, respectively.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to show proof of ownership as taught by *Adelsbach et al.* to prevent unlawful copying of content.

13. **As per claim 23**, *Durand et al.* in view of *Adelsbach et al.* discloses the method of claim 21. *Durand et al.* further discloses wherein the transaction between at least one of the verified legal owner and an acquirer comprises the steps of:

receiving, from the verified legal owner of the item, a request for a copy of the item (FIG. 3);

distributing a verified copy of the digital master from the central media database to the verified legal owner, via the exchange interface (FIG. 3).

14. **As per claim 32**, *Durand et al.* does not explicitly disclose verifying that the owner legally possesses the item further comprises receiving documentation from the owner, wherein the documentation is sufficient to prove that the owner is the legal owner of the item.

Adelsbach et al. discloses an ownership certificate for proof of rightful copyright owner of a work is provided by a protocol for registering the work. Two protocols are provided to prove to a buyer that an ownership claim is valid by providing the certificate as required, and to show another buyer that work is obtained from rightful owner, respectively (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to show proof of ownership as taught by *Adelsbach et al.* to prevent unlawful copying of content.

15. **As per claim 36**, *Durand et al.* discloses a method for operating a commercial exchange of items accessible on a peer-to-peer network comprising the steps of:

receiving, from an owner of the item, a request to list the item on the commercial exchange (page 1, lines 33-37; page 3, line 33- page 4, line 4);

determining whether a digital master of the item exists in a central media database, storing the digital master in the central media database and assigning a unique digital master identifier associated with the digital master when the digital master of the item does not exist in the database and selecting the unique digital master identifier associated with the digital master when the digital master of the item does exist in the database (page 5, lines 3-8, page 8, lines 13-19; page 6, lines 13-19; page 16, lines 7-11);

assigning a unique owner identifier to the digital master of the item stored in the central media database, the unique owner identifier associating the legal owner of the item with the digital master (page 2, lines 8-11, page 16, lines 13-19, page 25, line 23- page 26, line 3);

maintaining a list of digital masters, the associated unique digital master identifiers, and the associated owner identifiers in the central media database (page 16,

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lines 7-11);

operatively associating the central media database with an exchange interface structured and operable to execute a transaction between at least one of the verified legal owner and an acquirer (page 1, lines 33-37; page 6, lines 23-31; FIG. 3);

maintaining a searchable index of digital masters offered for sale by members of the peer-to-peer network and corresponding to a unique digital master contained in the central media database (page 13, lines 6-14);

searching said index to identify a unique digital master desired for acquisition by an acquirer (page 13, lines 6-14).

Durand et al. does not explicitly disclose verifying that the owner legally possesses the item.

Adelsbach et al. discloses an ownership certificate for proof of rightful copyright owner of a work is provided by a protocol for registering the work. Two protocols are provided to prove to a buyer that an ownership claim is valid by providing the certificate as required, and to show another buyer that work is obtained from rightful owner, respectively (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to show proof of ownership as taught by *Adelsbach et al.* to prevent unlawful copying of content.

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16. **Claims 22 and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Durand et al.* (WO 02/054196 A2), in view of *Adelsbach et al.* (US Patent No. 6,856,977), as applied to claim 21 above and further in view of *Cooper et al.* (US PG Pub. 2009/0037388).

17. **As per claim 22**, *Durand et al.* in view of *Adelsbach et al.* discloses the method of Claim 21, but does not specifically disclose the step of receiving, from an owner of the item, a physical copy of the item prior to determining whether the digital master of the item exists in the central media database, wherein the commercial exchange immobilizes the physical copy of the item.

Cooper et al. discloses the pointer to the data may be a pointer to the physical data that resides with the customer sites 270. In another embodiment, a number or string of characters that uniquely identify the content ordered by the consumer may be used rather than a pointer to the content data. *When the content material is to be downloaded to the user, the archive server 240 may be accessed in order to get a pointer to the physical data, or alternatively to locate the physical data on the storage facilities within the archive server 240 [0250]*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to use a pointer to the physical data as taught by *Cooper et al.* in order to digitize content.

18. **As per claim 31**, *Durand et al.* in view of *Adelsbach et al.* discloses the method of Claim 21, but does not explicitly disclose wherein the step of verifying that the owner

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legally possesses the item further comprises receiving a physical copy of the item from the owner.

Cooper et al. discloses shipping and handling information that will be helpful if the consumer wishes to receive a physical copy from the content provider ([0182]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability receive physical copies of content as taught by *Cooper et al.* for the benefit of providing content to those not wanting digital copies to download.

19. **Claims 24-30 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Durand et al.* (WO 02/054196 A2), in view of *Adelsbach et al.* (US Patent No. 6,856,977), as applied to claims 21, 31, and 36 above, further in view of *Cooper et al.* (US PG Pub. 2009/0037388), in view of McCleskey et al. (US PG Pub. 2005/0021398).

20. **As per claim 24**, *Durand et al.* in view *Adelsbach et al.* discloses the method of Claim 21, wherein the transaction between at least one of the verified legal owner and an acquirer comprises the steps of:

transferring a payment from the acquirer to the verified legal owner via the exchange interface (FIG. 3); and

distributing a copy of the item to the acquirer (FIG. 3).

Durand et al. in view *Adelsbach et al.* does not explicitly disclose receiving, from the verified legal owner of the item, permission to permanently transfer ownership rights in the item to another; and receiving, from the acquirer, a request to permanently

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transfer ownership rights in the item to the acquirer.

Cooper et al. discloses receiving, from the verified legal owner of the item, permission to permanently transfer ownership rights in the item to another ([0090] *allowing the consumer to decide to transfer ownership of the content to another*)

receiving, from the acquirer, a request to permanently transfer ownership rights in the item to the acquirer ([0090],[0095] *allowing the consumer to decide to transfer ownership of the content to another*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to transfer ownership as taught by *Cooper et al.* to give the rights to a purchaser.

Durand et al. in view of *Adelsbach et al.* in view of *Cooper et al.* does not explicitly disclose updating the list of unique owner identifiers and the associated unique digital master identifiers to reflect that the acquirer, rather than the owner, is the verified legal owner of the item.

McCleskey et al. discloses the present embodiment of this invention also provides the capability of the digital acknowledgement trigger to automatically acknowledge when an advertiser or file content owner changes or should be removed (expires) ([0187]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Laurent et al.* in view of *Cooper et al.* to include the ability to update ownership of content as taught by *McCleskey et al.* in order to send payments/royalties to the rightful owner.

21. **As per claim 25**, *Durand et al.* in view *Adelsbach et al.* in view of *Cooper et al.* in view of *McCleskey et al.* discloses the method of Claim 24. *Durand et al.* further discloses wherein the step of distributing a copy of the item to the acquirer comprises distributing a verified copy of the digital master from the central media database to the acquirer, via the exchange interface (pg. 6, lines 10-12).

22. **As per claim 26**, *Durand et al.* in view *Adelsbach et al.* does not specifically disclose the step of receiving, from an owner of the item, a physical copy of the item prior to determining whether the digital master of the item exists in the central media database, wherein the commercial exchange immobilizes the physical copy of the item.

Cooper et al. discloses the pointer to the data may be a pointer to the physical data that resides with the customer sites 270. In another embodiment, a number or string of characters that uniquely identify the content ordered by the consumer may be used rather than a pointer to the content data. *When the content material is to be downloaded to the user, the archive server 240 may be accessed in order to get a pointer to the physical data, or alternatively to locate the physical data on the storage facilities within the archive server 240 [0250].*

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to use a pointer to the physical data as taught by *Cooper et al.* in order to digitize the content.

23. **As per claim 27**, *Durand et al.* in view *Adelsbach et al.* does not disclose the step of removing the association between the unique owner identifier of the acquirer and the associated unique digital master identifier of the item from the list of unique owner identifiers and the associated unique digital master identifiers, wherein the step of distributing a copy of the item to the acquirer comprises distributing a physical copy of the item to the acquirer.

Cooper et al. discloses *shipping and handling information that will be helpful if the consumer wishes to receive a physical copy from the content provider ([0182])*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to sell physical copies of content as taught by *Cooper et al.* for the benefit of those not wanting to purchase digital content.

24. **As per claim 28**, *Durand et al.* in view *Adelsbach et al.* discloses the step of transferring a payment from the acquirer to the verified legal owner via the exchange interface comprising the steps of:

receiving a payment from the acquirer (FIG. 3).

Durand et al. in view *Adelsbach et al.* does not disclose crediting a portion of the payment to an account owned by the commercial exchange; and

crediting an account owned by the verified legal owner with an amount equal to the payment received from the acquirer less the portion of the payment to credited to the account owned by the commercial exchange.

Cooper et al. discloses a *Global Digital Rights Apportionment System (GDRAS) 230 makes it possible to apportion the money that is designated for artists, copyright owners, content owners, and other deserving entities in an efficient manner.* A GDRAS 230 monitors digital certificates that are issued specifically for content files. In addition, the GDRAS 230 checks the transaction database 214 for the total amount of money collected from the user, and apportion all monies collected appropriately. In some cases, money will go to customer sites 270. In other cases, money will go to royalty collection bodies, for example the Recording Industry Association of America (RIAA), or other appropriate individual or entity ([0094],[0196]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to apportion payments to the proper parties as taught by *Cooper et al.* in order to process payments for the content.

25. **As per claim 29**, *Durand et al.* in view *Adelsbach et al.* discloses the method of Claim 21, but does not explicitly disclose wherein the transaction between at least one of the verified legal owner and an acquirer comprises the steps of:

receiving, from the verified legal owner of the item, permission to transfer ownership rights in the item to another; and

receiving, from the acquirer, a request to transfer ownership rights in the item to the acquirer.

Cooper et al. discloses allowing the consumer to decide to transfer ownership of the content to another ([0090],[0095])). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to transfer ownership as taught by *Cooper et al.* to give the rights to a purchaser.

Durand et al. in view *Adelsbach et al.* in view of *Cooper et al.* does not explicitly disclose permission to transfer ownership rights in the item to another is for a predetermined period of time;

updating the list of unique owner identifiers and the associated unique digital master identifiers to reflect that the acquirer, rather than the owner, is the verified legal owner of the item, wherein the owner is denied access to the item prior to the expiration of the predetermined period of time; and

updating the list of unique owner identifiers and the associated unique digital master identifiers to reflect that the owner, rather than the acquirer, is the verified legal owner of the item after the expiration of the predetermined period of time.

McCleskey et al. discloses the present embodiment of this invention also provides the capability of the digital acknowledgement trigger to automatically acknowledge when an advertiser or file content owner changes or should be removed (expires) ([0187])). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* in view of *Cooper et al.* to include the ability to updates ownership of content as taught by *McCleskey et al.* in order to send payments/royalties to the rightful owner.

26. **As per claim 30**, *Durand et al.* in view *Adelsbach et al.* discloses the method of Claim 21, but does not specifically disclose wherein the transaction between at least one of the verified legal owner and an acquirer comprises the steps of:

receiving, from a first verified legal owner of a first item, permission to permanently transfer ownership rights in the first item to another; and

receiving, from the acquirer who is the verified legal owner of a second item, permission to permanently transfer ownership rights in the second item to another;

receiving, from the first verified legal owner of the first item, a request to acquire ownership rights in the second item; and

receiving, from the acquirer, a request to acquire ownership rights in the first item.

Cooper et al. discloses *allowing the consumer to decide to transfer ownership of the content to another ([0090],[0095])*. *Cooper et al.* discloses does not explicitly disclose a first or second item, however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ere could be multiple items (content) exchanged. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability to transfer ownership as taught by *Cooper et al.* to give the rights to a purchaser.

Durand et al. in view *Adelsbach et al.* in view of *Cooper et al.* does not explicitly disclose updating the list of unique owner identifiers and the associated unique digital

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master identifiers to reflect that the acquirer, rather than the owner, is the verified legal owner of the first item; and that the owner, rather than the acquirer, is the verified legal owner of the second item.

McCleskey et al. discloses the present embodiment of this invention also provides the capability of the digital acknowledgement trigger to automatically acknowledge when an advertiser or file content owner changes or should be removed (expires) ([0187]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* in view of *Cooper et al.* to include the ability to updates ownership of content as taught by *McCleskey et al.* in order to send payments/royalties to the rightful owner.

27. **As per claim 37**, *Durand et al.* in view *Adelsbach et al.* discloses the method of Claim 36, wherein the transaction between at least one of the verified legal owner and an acquirer comprises the steps of:

transferring a payment from the acquirer to the verified legal owner via the exchange interface (FIG. 3); and

distributing a copy of the item to the acquirer (page 13, lines 6-14; FIG. 3).

Durand et al. in view *Adelsbach et al.* does not explicitly disclose receiving, from the verified legal owner of the item, permission to permanently transfer ownership rights in the item to another;

receiving, from the acquirer, a request to permanently transfer ownership rights in the item to the acquirer.

Cooper et al. discloses allowing the consumer to decide to transfer ownership of the content to another ([0090],[0095]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Laurent et al.* to include the ability to transfer ownership as taught by *Cooper et al.* to give the rights to a purchaser.

Durand et al. in view of *Adelsbach et al.* in view of *Cooper et al.* does not explicitly disclose updating the list of unique owner identifiers and the associated unique digital master identifiers to reflect that the acquirer, rather than the owner, is the verified legal owner of the item.

McCleskey et al. discloses the present embodiment of this invention also provides the capability of the digital acknowledgement trigger to automatically acknowledge when an advertiser or file content owner changes or should be removed (expires) ([0187]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* in view of *Cooper et al.* to include the ability to update ownership of content as taught by *McCleskey et al.* in order to send payments/royalties to the rightful owner.

28. **Claims 33-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Durand et al.* (WO 02/054196 A2), in view of *Adelsbach et al.* (US Patent No. 6,856,977), as applied to claim 21 above, further in view of *Jeran et al.* (US Patent No. 6,842,740), in view of *Cooper et al.* (US PG Pub. 2009/0037388), and further view of *McCleskey et al.* (US PG Pub. 2005/0021398),

29. **As per claim 33**, *Durand et al.* in view *Adelsbach et al* discloses the method of Claim 21, further comprising the steps of: transferring a payment from the acquirer to the verified legal owner via the exchange interface (FIG. 3); and

distributing a copy of the item to the acquirer(page 13, lines 6-14; FIG. 3).

Durand et al. in view *Adelsbach et al* does not specifically disclose verifying that the verified legal owner holds a copyright in the item; and

receiving, from the verified legal owner of the item, permission to produce a predetermined number of copies of the item.

Jeran et al. discloses in order to control unauthorized copying, some companies require their employees to order preprints from the publisher, or to negotiate a direct arrangement with the copyright holder for the right to make a predetermined number of copies (col. 1, lines 23-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability get permission to make copies of content as taught by *Jeran et al.* in order to prevent unlawful copying.

Durand et al. in view of *Jeran et al.* does not explicitly disclose receiving, from the acquirer, a request to permanently transfer ownership rights in a copy of the item to the acquirer.

Cooper et al. discloses *allowing the consumer to decide to transfer ownership of the content to another ([0090],[0095])*. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of

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Laurent et al. to include the ability to transfer ownership as taught by *Cooper et al.* to give the rights to a purchaser.

Durand et al. in view *Adelsbach et al.*, *Jeran et al.* and *Cooper et al.* does not explicitly disclose updating the list of unique owner identifiers and the associated unique digital master identifiers to reflect that the acquirer, rather than the owner, is the verified legal owner of the item.

McCleskey et al. discloses the present embodiment of this invention also provides the capability of the digital acknowledgement trigger to automatically acknowledge when an advertiser or file content owner changes or should be removed (expires) ([0187]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* in view of *Jeran et al.* in view of *Cooper et al.* to include the ability to updates ownership of content as taught by *McCleskey et al.* in order to send payments/royalties to the rightful owner.

30. **As per claim 34**, *Durand et al.* in view *Adelsbach et al.* in view of *Jeran et al.* in view of *Cooper et al.* in view of *McCleskey et al.* discloses the method of Claim 33. *Durand et al.* further discloses wherein the step of distributing a copy of the item to the acquirer comprises distributing a verified copy of the digital master from the central media database to the acquirer, via the exchange interface (FIG. 3).

31. **As per claim 35**, *Durand et al.* in view of *Adelsbach et al.* does not explicitly disclose wherein the step of distributing a copy of the item to the acquirer comprises distributing a physical copy of the item to the acquirer.

Cooper et al. discloses shipping and handling information that will be helpful if the consumer wishes to receive a physical copy from the content provider ([0182]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of *Durand et al.* to include the ability receive physical copies of content as taught by *Cooper et al.* for the benefit of providing content to those not wanting digital copies to download.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FREDA A. NELSON whose telephone number is (571)272-7076. The examiner can normally be reached on Monday-Tuesday and Thursday, 10:15 am - 6:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A. N./
Examiner, Art Unit 3628

/IGOR BORISSOV/
Primary Examiner, Art Unit 3628